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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,403	07/14/2003	Uchenna N. Chukwu	C514.12-0004	7660

7590 07/23/2007  
Uchenna N Chukwu  
Chi's Research Corporation  
5354 Beachside Drive  
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EXAMINER

CORBIN, ARTHUR L

ART UNIT	PAPER NUMBER
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1761

MAIL DATE	DELIVERY MODE
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07/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/619,403

Applicant(s)

CHUKWU, UCHENNA N.

Examiner

Arthur L. Corbin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 14 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 21, 22, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 3, 8, 10 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The disclosure is objected to because of the following informalities: The specification (page 2, line 27) fails to disclose the current status of SN 09/495,960.

Appropriate correction is required.

2. Claims 3, 8, 10 and 28 are objected to because of the following informalities: In claims 3 and 28, "a" should be changed to "the". In claim 8, line 2, "enzymes" should be singular. In claim 10, line 1, "in said" should be added after "vegetable". Appropriate correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for the vegetable being a grain (claim 10) or for the enzyme composition being effective to "reduce" raffinose and stachyose, which can be corrected by changing "reduce" to "degrade", as disclosed on page 28 of applicant's specification. Corrections are required.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 14, 21, 22, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhlig et al (3,640,723). Uhlig et al is described on page 3 of the September 5, 2006 Office action. Although Uhlig et al treats soybean meal rather than "whole" soybeans, as applicant now claims, there is no patentable distinction between the size of the two starting materials, especially since "whole" is merely preferred by applicant (spec, page 16) and since "whole" may include "chopped" (spec, page 19). Further, preferred limitations, without more, are not critical (In re Rauch, 156 USPQ 502). Alpha-galactosidase and alpha-amylase (claim 21) are well known and viable alternatives to the hemicellulase used in Uhlig et al. Degradation of raffinose and stachyose (claim 28) is the natural, and thus obvious, result of enzymatic treatment of vegetable material.

7. Claims 1-8, 27 and 28 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Lendvay (3,705,810) as set forth on page 4 of said Office action. Applicant is also referred to lines 4-11 in paragraph no. 6 above.

8. Claims 1-11, 14, 21, 22, 27 and 28 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (3,845,220) as set forth on page 5 of said Office action. Applicant is referred to lines 4-11 in paragraph no. 6 above.

9. Newly submitted claims 23-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the composition

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claimed in claims 23-26 can be prepared without the deactivating step of the method claims and without limiting the pH of the enzyme.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-26 stand withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

10. Applicant's arguments filed December 6, 2006 have been fully considered but they are not persuasive. The particular size of applicant's starting material is not critical and in the absence of unexpected results is entitled to no patentable weight. The green coffee beans in Lendvay are raw, according to applicant's claim 10. Further, processed coffee beans are still raw if they are not roasted. Suzuki treats parched coffee beans and not just coffee extract liquid, as applicant contends on page 10, line 19 of remarks, according to the examples in Suzuki and as also admitted by applicant in the remarks (page 10, lines 14-15).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

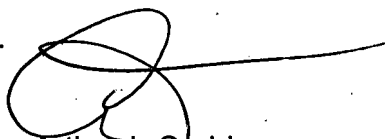
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith D. Hendricks, can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, consisting of a large, stylized loop followed by a horizontal line extending to the right.

Arthur L. Corbin  
Primary Examiner  
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7-19-07